

*Atty Docket: 210589US (4081-05300)**Patent***REMARKS/ARGUMENTS*****Status of Claims***

Claims 1-2, 5-7, 9-12, 14, 18-22, 25-27, 29-32, and 34-37 have been amended.

Claims 4 and 24 have been canceled.

As such, claims 1-3, 5-23, and 25-42 are pending in this patent application.

Applicants hereby request further examination and reconsideration of the presently claimed application.

35 USC § 112 Rejections

Claims 1, 3-21 and 23-42 have been amended to comply with the written description requirement by replacement of the term "cystol ester" or "cystol esters" with "cystosol ester" and "cystosol esters" respectively. Furthermore, the specification has been amended to include the following sentence, "Cystol esters are also commonly termed cystosol esters and may be referred to herein as such." The Applicants wish to note that other synonyms of cystosol are D-sorbitol, D-glucitol, L-glucitol, Sorbit, Rcsolax, Sorbilax, Sorbitur, Sorbo, Sobostyl or Sorbilande as per the Merck Index, 13th Edition, 2001, p.8974.

Claims 35-37 have been amended to remove the phrase "capable of".

Allowable subject matter

Applicants note with appreciation that claims 7, 9, 14-20, 27, 29, 34-37, and 39-42 do not stand rejected on the basis of prior art. Accordingly, Applicants have rewritten claims 9 and 29 in independent form. Therefore, claim 9 with dependent claims 14-20 and claim 29 with dependent claims 34-37 are now in condition for allowance.

Atty Docket: 210589US (4081-05300)**Patent*****Rejections over Saito***

Claims 1-6, 8, 10-12, 21-26, 28, 30-32, and 38 stand rejected under 35 USC § 102(b) as being anticipated by *Saito* (US 4,259,225). Claims 1-8, 10-12, 21-28, 30-32, and 38 stand rejected under 35 USC § 103(a) as being obvious over *Saito* (US 4,259,225). Applicants respectfully submit that *Saito* does not establish a *prima facie* case of anticipation or obviousness as to the pending claims. According to MPEP § 2131, “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” Likewise, MPEP 2142 requires that “the prior art reference must teach or suggest all the claim limitations” in order to establish a *prima facie* case of obviousness. Applicants respectfully submit that *Saito* does not teach or suggest each and every limitation set forth in the pending claims, and therefore does not anticipate or make obvious the pending claims. Specifically, Applicants have amended independent claim 1 to recite a method for reducing sag in a wellbore servicing fluid composition and independent claim 21 to recite a wellbore servicing fluid composition. Applicants respectfully submit that wellbore servicing fluids are a well-recognized class of compounds and that the amendments to the independent claims positively recite such. In contrast, *Saito* is related to colored polyvinyl paste compositions, and thus is nonanalogous art to the subject matter recited in the amended claims. Accordingly, *Saito* does not teach or suggest each and every element of the pending claims, namely the recited wellbore servicing fluid compositions, and thus Applicants respectfully request that the prior art rejections over *Saito* be withdrawn.

Rejections over Bock

Claims 1-6, 8, 13, 21-26, 28, 33 and 38 stand rejected under 35 USC § 103(a) as being obvious over *Bock* (US 4,458,757), optionally in view of *Saito* (US 4,259,225), *Rothrock* (US

Atty Docket: 210589US (4081-05300)

Patent

2,437,046), and/or *Smutny* (US 3,112,338). Applicants respectfully submit that the prior art of record does not establish a *prima facie* case of obviousness as to the pending claims. According to MPEP 2142, three basic criteria must be met to establish a *prima facie* case of obviousness:

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

Applicants respectfully submit that a *prima facie* case of obviousness does not exist because there is no motivation or suggestion to modify and/or combine the prior art references. Applicants note with appreciation the Examiner's helpful comment on page 8 of the office action that Applicants have written the claims very broadly for the most part, so what is considered relevant prior art here may be taken commensurately. As noted previously, Applicants have amended independent claim 1 to recite a method for reducing sag in a wellbore servicing fluid composition and independent claim 21 to recite a wellbore servicing fluid composition. Applicants respectfully submit that wellbore servicing fluids are a well-recognized class of compounds and that the amendments to the independent claims positively recite such. Given that the subject matter of the secondary references, *Saito*, *Rothrock*, and/or *Smutny*, is not commensurate with that of the amended claims, Applicants respectfully submit that there is no motivation or suggestion to combine the secondary references with the primary reference, *Bock*. Furthermore, absent the teaching of the secondary references or the impermissible use of hindsight, Applicants respectfully submit that there is no motivation to modify *Bock* to select the specific cystosol ester compounds recited in the pending claims, for example the compounds recited in claims 2, 6, 7, 22, 26, and 27. In view of the lack of motivation or suggestion to modify and/or combine the references,

Atty Docket: 210589US (4081-05300)**Patent**

Applicants respectfully submit that claims 1-6, 8, 13, 21-26, 28, 33 and 38 are allowable over the prior art of record.

Rejections over McCabe

Claims 1-6, 10-13, 21-26, 30-33, and 38 stand rejected under 35 USC § 103(a) as being obvious over *McCabe* (US Pat. App. Pub. 2005/0087341) optionally in view of *Saito* (US 4,259,225), *Rothrock* (US 2,437,046), and/or *Smutny* (US 3,112,338). Applicants respectfully submit that the prior art of record does not establish a *prima facie* case of obviousness as to the pending claims. According to MPEP 2142, three basic criteria must be met to establish a *prima facie* case of obviousness:

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

Applicants respectfully submit that a *prima facie* case of obviousness does not exist because there is no motivation or suggestion to modify and/or combine the prior art references. Applicants note with appreciation the Examiner's helpful comment on page 10 of the office action that Applicants have written the claims very broadly for the most part, so what is considered relevant prior art here may be taken commensurately. As noted previously, Applicants have amended independent claim 1 to recite a method for reducing sag in a wellbore servicing fluid composition and independent claim 21 to recite a wellbore servicing fluid composition. Applicants respectfully submit that wellbore servicing fluids are a well-recognized class of compounds and that the amendments to the independent claims positively recite such. Given that the subject matter of the secondary references, *Saito*, *Rothrock*, and/or *Smutny*, is not commensurate with that of the

Atty Docket: 210589US (4081-05300)**Patent**

amended claims, Applicants respectfully submit that there is no motivation or suggestion to combine the secondary references with the primary reference, *McCabe*. Furthermore, absent the teaching of the secondary references or the impermissible use of hindsight, Applicants respectfully submit that there is no motivation to modify *McCabe* to select the specific cystosol ester compounds recited in the pending claims, for example the compounds recited in claims 2, 6, 7, 22, 26, and 27. In view of the lack of motivation or suggestion to modify and/or combine the references, Applicants respectfully submit that claims 1-6, 10-13, 21-26, 30-33, and 38 are allowable over the prior art of record.

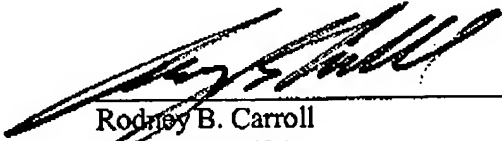
*Atty Docket: 210589US (4081-05300)**Patent***CONCLUSION**

Consideration of the foregoing amendments and remarks, reconsideration of the application, and withdrawal of the rejections or objections is respectfully requested by Applicants. No new matter is introduced by way of the amendment. It is believed that each ground of rejection raised in the Office Action dated January 13, 2006 has been fully addressed. If any fee is due as a result of the filing of this paper, please appropriately charge such fee to Deposit Account Number 50-1515 of Conley Rose, P.C., Texas. If a petition for extension of time is necessary in order for this paper to be deemed timely filed, please consider this a petition therefore.

If a telephone conference would facilitate the resolution of any issue or expedite the prosecution of the application, the Examiner is invited to telephone the undersigned at the telephone number given below.

Respectfully submitted,

CONLEY ROSE, P.C.

Date: 4-13-06
Rodney B. Carroll
Reg. No. 39,624

5700 Granite Parkway, Suite 330
Plano, Texas 75024
(972) 731-2288

ATTORNEY FOR APPLICANTS